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EXAMINER
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WINTER, JOHN M

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3621

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**GROUP 3600**

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/877,157  
Filing Date: June 08, 2001  
Appellant(s): BLEIZEFFER ET AL.

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Duke W. Yee  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed February 28, 2005.

**(1) Real Party in Interest**

A statement identifying the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The brief contains a statement that no related and/or interferences are pending.

**(3) Status of Claims**

The statement of the status of the claims contained in the brief is correct

**(4) Status of Amendments After Final.**

The Appellant's statement of the status of amendments after final rejection contained in the brief is correct

**(5) Summary of the Invention.**

The summary of the invention contained in the brief is correct.

**(6) Issues.**

The Appellant's statement of the issues in the brief is correct.

**(7) Grouping of Claims.**

The Appellant's brief includes a statement that the claims stand or fall together.

**(8) Claims Appealed.**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) Prior Art Record.**

6,158,010	Moriconi	12/2000
WO 98/40987	Abraham	03/1998

**(10) Ground of Rejection.**

***Claim Rejections - 35 USC §101***

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35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 1 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In claim 1 the applicant claims a method for creating policy groups, moving a data element between groups and generating a privacy policy based upon the policy group. This process might be performed without the aid of any technology and therefore the claimed method is not within the technological arts.

All that is necessary to make a sequence of operational steps in a statutory process within 35 U.S.C. 101 is that it be in the technological arts so as to be in concordance with the Constitutional purpose to promote the progress of "useful arts" *In re Musgrave*, 431 F.2d 882 167 USPQ 280 (CCPA 1970)

A claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result: i.e. the method recites a step or act of producing something that is concrete, tangible and useful. *See AT&T v. Excel Communications Inc.*, 172 F3d at 1358, 50 USPQ2d at 1452.

Claims 1-5 and 8-11 are dependant on rejected claim 1, and are rejected for at least the same reasons.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1- 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moriconi et al (US Patent 6,158,010) in view of Abraham et al. (WO 98/40987).

As per claim 1,

Moriconi et al ('010) discloses a method for creating a privacy policy, comprising:  
moving a data element to the policy group;(Figure 9)  
generating a privacy policy based on the policy group.(Figure 4)

Moriconi et al ('010) does not explicitly disclose creating a policy group, Abraham et al. ('987) discloses creating a policy group.(Abstract) It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Moriconi et al ('010)'s method with the Abraham et al. ('987)'s method in order to secure management of a computer network

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As per claim 2,  
Moriconi et al ('010) discloses the method of claim 1,  
wherein the data element is a predefined data element.(Column 6, lines 20-26)

As per claim 3,  
Moriconi et al ('010) discloses the method of claim 1,  
wherein the data element comprises at least one sub-element.(Column 6, lines 46-51)

As per claim 4,  
Moriconi et al ('010) discloses the method of claim 1, further comprising:  
updating a policy-wide property; and generating the privacy policy based on the policy-  
wide property.(Column 5, lines 48-55)

As per claim 5,  
Moriconi et al ('010) discloses the method of claim 1,  
wherein the step of generating a privacy policy comprises generating a human readable  
version of the policy.(Column 9, lines 45-50 – Examiner notes that although Moriconi et al does  
not specifically disclose “generating a human readable version of the policy” it would be obvious  
that if the policy is manipulated via a GUI it would be readable to the user.)

As per claim 6,  
Moriconi et al ('010) discloses the method of claim 5,  
Official Notice is taken that “hypertext markup language version of the policy” is  
common and well known in prior art in reference to policy management. It would have been  
obvious to one having ordinary skill in the art at the time the invention was made to render the  
policy in HTML format in order to provide a format that is universally viewable across a wide  
variety of computer platforms and operating systems.

As per claim 7,  
Moriconi et al ('010) discloses the method of claim 1,  
Official Notice is taken that “generating an extensible markup language version of the  
policy” is common and well known in prior art in reference to policy management. It would  
have been obvious to one having ordinary skill in the art at the time the invention was made to  
render the policy in XML format in order to provide a format that is universally viewable across  
a wide variety of computer platforms and operating systems.

As per claim 8,  
Moriconi et al ('010) discloses the method of claim 1,  
wherein the step of generating a privacy policy comprises generating a compact  
policy.(Figure 4 – note element 436 optimizer)

As per claim 9,  
Moriconi et al ('010) discloses the method of claim 1,

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wherein the step of generating a privacy policy comprises generating a policy statement corresponding to the policy group.(Figure 4)

As per claim 10,  
Moriconi et al ('010) discloses the method of claim 9,  
wherein the step of generating a privacy policy further comprises generating a table of policy elements, wherein a policy element in the table of policy elements corresponds to the policy statement.(Column 4, lines 34-37—the rules [i.e. elements] are stored in a database [i.e. table])

As per claim 11,  
Moriconi et al ('010) discloses the method of claim 1,further comprising:  
identifying an error in the privacy policy;(Column 11, lines 44-46 – Although Moricini does not specifically disclose generating an error statement describing the error he does disclose generating a log file, it is well known within modern computing systems to automate the generation of error reports from log files)

As per claim 12,  
Moriconi et al ('010) discloses an apparatus for creating a privacy policy, comprising:  
movement means for moving a data element to the policy group;(Figure 9)  
generation means for generating a privacy policy based on the policy group.(Figure 4)  
Moriconi et al ('010) does not explicitly disclose creation means for creating a policy group, Abraham et al. ('987) discloses creation means for creating a policy group.(Abstract) It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Moriconi et al ('010)'s apparatus with the Abraham et al. ('987)'s apparatus in order to secure management of a computer network

As per claim 13,  
Moriconi et al ('010) discloses the apparatus of claim 12,  
wherein the data element is a predefined data element.(Column 6, lines 20-26)

As per claim 14,  
Moriconi et al ('010) discloses the the apparatus of claim 12,  
wherein the data element comprises at least one sub-element. (Column 6, lines 46-51)

As per claim 15,  
Moriconi et al ('010) discloses the apparatus of claim 12, further comprising:  
means for updating a policy-wide property; and means for generating the privacy policy based on the policy-wide property.(Column 5, lines 48-55)

As per claim 16,  
Moriconi et al ('010) discloses the apparatus of claim 12,  
wherein the generation means comprises means for generating a human

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readable version of the policy.(Column 9, lines 45-50 – Examiner notes that although Moriconi et al does not specifically disclose “generating a human readable version of the policy” it would be obvious that if the policy is manipulated via a GUI it would be readable to the user.)

As per claim 17

Moriconi et al ('010) discloses the apparatus of claim 16,

Official Notice is taken that “hypertext markup language version of the policy” is common and well known in prior art in reference to policy management. It would have been obvious to one having ordinary skill in the art at the time the invention was made to render the policy in HTML format in order to provide a format that is universally viewable across a wide variety of computer platforms and operating systems.

As per claim 18

Moriconi et al ('010) discloses the apparatus of claim 19,

Official Notice is taken that “generating an extensible markup language version of the policy” is common and well known in prior art in reference to policy management. It would have been obvious to one having ordinary skill in the art at the time the invention was made to render the policy in XML format in order to provide a format that is universally viewable across a wide variety of computer platforms and operating systems.

As per claim 19,

Moriconi et al ('010) discloses the apparatus of claim 12,

wherein the generation means comprises means for generating a compact policy.(Figure 4 – note element 436 optimizer)

As per claim 20,

Moriconi et al ('010) discloses the apparatus of claim 12,

wherein the generation means comprises means for generating a policy statement corresponding to the policy group.(Figure 4)

As per claim 21

Moriconi et al ('010) discloses the apparatus of claim 20,

wherein the generation means further comprises means for generating a table of policy elements, wherein a policy element in the table of policy elements corresponds to the policy statement.(Column 4, lines 34-37—the rules [i.e. elements] are stored in a database [i.e. table])

As per claim 22,

Moriconi et al ('010) discloses the apparatus of claim 12, further comprising: means for identifying an error in the privacy policy;(Column 11, lines 44-46 – Although Moricini does not specifically disclose generating an error statement describing the error he does disclose generating a log file, it is well known within modern computing systems to automate the generation of error reports from log files)

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As per claim 23,

Moriconi et al ('010) discloses an interface for creating a privacy policy, comprising:  
a first portion for displaying predefined data elements;(Column 9, lines 45-50)

a second portion for displaying groups of data elements, wherein a group of data elements shares at least one common property;(Figure 4)

Moriconi et al ('010) does not explicitly disclose a third portion for displaying a privacy policy generated from the groups of data elements, Abraham et al. ('987) discloses a third portion for displaying a privacy policy generated from the groups of data elements.(Abstract) It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Moriconi et al ('010)'s method with the Abraham et al. ('987)'s method in order to secure management of a computer network

As per claim 24,

Moriconi et al ('010) discloses a computer program product, in a computer readable medium, for creating a privacy policy, comprising:

instructions for moving a data element to the policy group(Figure 9)

instructions for generating a privacy policy based on the policy group.(Figure 4)

Moriconi et al ('010) does not explicitly disclose instructions for creating a policy group, Abraham et al. ('987) discloses instructions for creating a policy group.(Abstract) It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Moriconi et al ('010)'s method with the Abraham et al. ('987)'s method in order to secure management of a computer network

## **(11) Response to Argument.**

### **First Issue**

#### **A.1 Claims 1-11**

The Examiner states that although the preamble of Claim 1 recites "A data processing apparatus" there is no functional interrelationship between the language of the preamble and the body of the claim. . In claim 1 the applicant claims a method for creating policy groups, moving a data element between groups and generating a privacy policy based upon the policy group. This process might be performed without the aid of any technology and therefore the claimed method is not within the technological arts.

With respect to claims 2-11 the examiner finds that claims 6 and 7 embody a non-trivial use of technology, therefore the rejection under 35 U.S.C 101 is maintained upon claims 1-5, 8-11



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## A.2 Claims 12-22

The Examiner withdraws the rejection under 35 U.S.C 101 for claims 12-22

Second Issue

## B.1 Claims 1,12 and 24

In response to applicant's argument that the references to Moriconi et al (US Patent 6,158,010) in view of Abraham et al. (WO 98/40987) are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the applicant makes a series of generalized assertions concerning the relationship between privacy and security. The Examiner holds that broad generalizations as to the nature of the clients invention are inapplicable and that each claimed feature has been examined on it's own merits. The Moriconi reference describes a system by which a set of rules are applied to a set of users in a computer system, the examiner contends that in this specific instance the cited art demonstrates a policy for enforcing security and creating privacy at the same time.

## B.2. Claim 4 and 15

The examiner maintains that the Moriconi reference meets the claimed limitation of "updating a policy wide property, and generating a privacy policy based on a policywide property" ; as Moriconi states "a system for managing and enforcing security requirements in a distributed computer network ... and distributing a policy to a client" . The examiner contends that the management of a policy would include the updating of a policy and the distribution of the policy shows the adherence of multiple client tot a policywide property.

## B.3. Claim 5 and 16

The examiner maintains that if a Graphical User Interface is used then the content rendered by the GUI is obviously readable by humans.

## B.4. Claim 6,7,17 and 18

The examiner contends that the Applicant has made no formal challenge to the Official Notice taken in the prior rejections,

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To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed

fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also *Chevenard*, 139 F.2d at 713, 60 USPQ at 241 ("[I]n the absence of any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention."). A general allegation that the claims define a patentable invention without any reference to the examiner's assertion of official notice would be inadequate. If applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 ("[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings" to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2).

If applicant does not traverse the examiner's assertion of official notice or applicant's traverse is not adequate, the examiner should clearly indicate in the next Office action that the common knowledge or well-known in the art statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. If the traverse was inadequate, the examiner should include an explanation as to why it was inadequate.

#### B.5. Claim 10 and 21

The examiner contends that a table and a database are analogous features, Moriconi discloses a database (i.e. table) of policy rules and since the rules are a subset of the policy, each rule must correspond to at least one policy.

#### B.6. Claim 11 and 22

The examiner contends that although Moriconi does not specifically disclose generating an error statement describing the error he does disclose generating a log file, it is well known within modern computing systems to automate the generation of error reports from log files.

#### B.7. Claim 23

The examiner contends the Moriconi reference shows predefined data elements as per figure 9, i.e. users applications and roles, additionally Moriconi discloses different policies

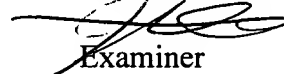
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grouped within the database management system (element 218 of figure 4). Abraham discloses a graphical interface which communicates policies (Abstract)

For the above reasons, it is believed that the rejections should be sustained,

Respectfully submitted

John M Winter



Examiner

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JMW

April 18, 2005

Conferees;

James Trammell

Hyung Sough



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SUPERVISORY PATENT EXAMINER  
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This is in response to the appeal brief filed February 8, 2005.